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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,716	03/10/2000	Edward P. Cohen	10464A	6035

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07/02/2002

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EXAMINER

YAEN, CHRISTOPHER H

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 07/02/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/522,716

Applicant(s)

COHEN, EDWARD P.

Examiner

Christopher H Yaen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 March 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26,41-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26,41-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

1. The examiner of the application has changed. This case has now been transferred as of 6/28/02. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Christopher Yaen, Group Art Unit 1642.
2. Amendment filed March 4, 2002 (paper no. 8) is acknowledged and has been entered. Claims 3-4, 16, and 29-40 have been canceled without prejudice. Claims 26, 41-46 are pending and are examined on the merits.

### *Information Disclosure Statement*

3. Supplemental Information Disclosure Statement (IDS) filed March 4, 2002 (paper no. 9) is acknowledged. A signed and dated copy of the IDS is included with this action.

### *Claim Rejections Maintained*

4. The rejection of claims 26, 39-46 under 35 USC § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art, is **maintained**, for the reasons of record.

Applicant argues that the administration of semi-allogeneic transfected cells to mice, was able to prevent the establishment of B16 tumor mass in the animal. Further, applicant argues that the semi-allogeneic cells prepared according to the specification of the instant application was able to prevent the occurrence of a tumor. Furthermore,

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applicant argues that the semi-allogeneic cells were able to inhibit the growth or pre-existing tumors in mice. Applicants argument have been fully considered, but are not found persuasive for the following reasons. Applicant points to examples in the specification wherein the administration of semi-allogeneic transfected cells and B16 tumor cells are injected into a mouse, wherein the combination of both semi-allogeneic cells and tumor cells were unable to establish tumor masses, thereby contending that the tumor cells were "prevented" from forming tumors; and wherein the administration of semi-allogeneic cells, to a mouse containing a pre-existing tumor mass, inhibited growth of tumor cells. The examples do not provide an enabling disclosure because all the examples are drawn to methods of inhibiting tumor cell growth in mice. The instant specification has not shown to one of skill in the art, that tumor cells can be prevented in humans, because as stated in the prior office action, one of skill in the art can not determine which members in the population would be in need of such prevention, because it is not known which individuals will be pre-disposed to the formation of tumors. Until such methods become available to one of skill in the art, agents and methods to used for the prevention of cancer can not be envisioned.

5. The rejection of claim 43 under 35 USC§ 102(b) as being anticipated by Payelle *et al*, is **maintained**, or the reasons of record. Applicants arguments have been fully considered, but are not found to be persuasive. Applicant argues that amendment to claim 43, to no longer read upon a hybrid cell obviated the anticipation of claim 43. This is not found persuasive because the semi-allogeneic cell still reads on the cell described by Payelle *et al*, wherein the semi-allogeneic cell comprises an APC cell, wherein the

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APC cell is a fibroblast, expresses MHC I or MHC II, and the fibrosarcoma disclosed by Payelle *et al* inherently contains genomic DNA from a tumor cell.

***Claim Rejections Withdrawn***

6. The rejection of claims 39-40, 43-46 under 35 UCS §103(a) as being obvious over Payelle *et al* in view of Kundig *et al*, is **withdrawn**, in view of the arguments set for by the applicant, which were persuasive.

***Conclusion***

7. No claim is allowed.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher H Yaen whose telephone number is 703-305-3586. The examiner can normally be reached on Monday-Friday 9-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Christopher Yaen  
Art Unit 1642  
June 29, 2002

*Brenda Brumback*  
**BRENDA BRUMBACK**  
**PATENT EXAMINER**  
*PRIMARY*